

Appl. No. : 09/631,576
Filed : August 4, 2000

REMARKS

Claims 40, and 77-79 have been amended. Support for the amendments can be found in the Specification and claims as filed, for example, Figures 2A-2C. The added claim language does no more than describe what is in Figures 2A-2C as filed. The changes made to the Claims by the current amendment, including deletions and additions, are shown herein with the ~~deletions~~ designated with a strikethrough and the additions underlined. No new matter has been added herewith.

Rejection under 35 U.S.C. §112, second paragraph

The Examiner rejected Claims 77-79 as indefinite for the recitation “extend generally in the plane of the optic (or haptic)” because the Examiner believes that this suggested that the structures could be interpreted as extending either parallel or perpendicular to said plane.

Without agreeing to the Examiner’s interpretation of the claim language, Applicants have amended the claim as suggested by the Examiner to include the language “wherein the plane of the optic is perpendicular to the optical axis”. Thus, Applicants submit that the language is definite and respectfully request withdrawal of the rejection under 35 U.S.C. §112, second paragraph.

Rejection under 35 U.S.C. §102(b)

The Examiner rejected Claims 40, 51-53, 56, 67, 68, 74, and 79-81 as anticipated by Benjamin (FR 2,728,459).

To be anticipatory under 35 U.S.C. § 102, a reference must teach each and every element of the claimed invention. *See Hybritech Inc. v. Monoclonal Antibodies, Inc.*, 802 F.2d 1367, 1379 (Fed. Cir. 1986). “Invalidity for anticipation requires that all of the elements and limitations of the claim are found within a single prior art reference. ... There must be no difference between the claimed invention and the reference disclosure, as viewed by a person of ordinary skill in the field of the invention.” *See Scripps Clinic & Research Foundation v. Genentech, Inc.*, 927 F.2d 1565 (Fed. Cir. 1991).

Independent Claims 40 and 79 have been amended to include the claim language “wherein said cleats on the haptic extend generally in the direction of the plane of the haptic, wherein the plane of the haptic is generally perpendicular to the optical axis when the optic is attached to the haptic.”

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Benjamin et al. teaches in Figure 15 cleat-like projections (47) in the form of mushrooms (projection 45/stem 46 on Figure 15) on the optic. Firstly, Benjamin et al. teaches that the cleats are on the optic rather than the haptic. Further, even if the cleat-like projections of Benjamin were on the haptic, they do not “extend generally in the direction of the plane of the haptic, wherein the plane of the haptic is generally perpendicular to the optical axis when the optic is attached to the haptic.” because the projection 45 clearly projects outwardly from the plane of the optic at a 90° angle.

Thus, Benjamin et al does not anticipate the invention because it does not provide that the cleats are on the haptic or that they “extend generally in the direction of the plane of the haptic, wherein the plane of the haptic is generally perpendicular to the optical axis when the optic is attached to the haptic.”, and Applicants respectfully request withdrawal of the rejection under 35 U.S.C. §102(b).

Rejection under 35 U.S.C. §§102(b) and 103(a)

The Examiner rejected Claims 77 and 78 as anticipated by or, in the alternative, obvious over Benjamin (FR 2,728,459).

The law is clear that three basic criteria must be met to establish a *prima facie* case of obviousness: (MPEP ¶2143):

First, there must be some suggestion or motivation, either in the references themselves or in the knowledge generally available to one of ordinary skill in the art, to modify the reference or to combine reference teachings. Second, there must be a reasonable expectation of success. Finally, the prior art reference (or references, when combined) must teach or suggest all the claim limitations. The teaching or suggestion to make the claimed combination and the reasonable expectation of success must both be found in the prior art, not in applicant's disclosure (*In re Vaack*, 947 F.2d 488, 20 USPQ2d 1440 (Fed. Cir. 1991)).

Amended Claims 77 and 78 are specific about the attachment of the cleats to the optic, having the language: “wherein said cleats on the optic extend generally in the direction of the plane of the optic, wherein the plane of the optic is generally perpendicular to the optical axis.”

As discussed in the 102 rejection above, Benjamin et al. teaches in Figure 15 cleat-like projections (47) in the form of mushrooms (projection 45/stem 46 on Figure 15) on the optic. These cleat-like projections clearly do not “extend generally in the direction of the plane of the optic, wherein the plane of the optic is generally perpendicular to the optical axis.” because the projection 45 clearly projects outwardly from the plane of the optic at a 90° angle.

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Thus, Benjamin et al does not anticipate the invention because it does not provide that the cleats "extend generally in the direction of the plane of the optic, wherein the plane of the optic is generally perpendicular to the optical axis.", and Applicants respectfully request withdrawal of the rejection under 35 U.S.C. §102(b). Further, Benjamin does not render the claimed invention obvious because Benjamin does not suggest all of the claim limitations. Benjamin does not teach or suggest that the cleats "extend generally in the direction of the plane of the optic, wherein the plane of the optic is generally perpendicular to the optical axis.".

Applicants respectfully request withdrawal of the rejection under 35 U.S.C. §103(a).

Conclusion

In view of the remarks herein, it is believed that the claims are allowable. However, should the Examiner have any further questions, please contact the undersigned at the telephone number appearing below.

Please charge any additional fees, including any fees for additional extension of time, or credit overpayment to Deposit Account No. 11-1410.

Respectfully submitted,

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Dated: August 4, 2004

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